

**IN THE DRAWINGS:**

Please replace Figure 3 with the Replacement Figure in Exhibit A.

**REMARKS**

The Office Action dated August 11, 2005, has been received and carefully considered. In this response, claims 1, 12, 15, 24, 28 and 35 have been amended, new claims 39-41 have been added, and claims 11, 23 and 34 have been cancelled without prejudice. Entry of the amendments to the claims 1, 12, 15 24, 28 and 35, the addition of claims 39-41 and the cancellation of claims 11, 23 and 34 without prejudice is respectfully requested. Reconsideration of the outstanding objections/rejections in the present application is also respectfully requested based on the following remarks.

I. **THE OBJECTION TO THE DRAWINGS**

On page 2 of the Office Action, the drawings were objected to under 37 CFR §1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 51, 53 and 60. Applicant has provided replacement drawings. *See* Exhibit A.

In view of the foregoing, it is respectfully requested that the aforementioned objection to the drawings be withdrawn.

II. **THE ANTICIPATION REJECTION OF CLAIMS 1, 15 AND 28**

On page 3 of the Office Action, claims 1, 15 and 28 were rejected under 35 U.S.C. § 102(e) as being anticipated by Daniels (U.S. Patent No. 6,343,327). This rejection is hereby respectfully traversed.

Under 35 U.S.C. § 102, the Patent Office bears the burden of presenting at least a prima facie case of anticipation. *In re Sun*, 31 USPQ2d 1451, 1453 (Fed. Cir. 1993) (unpublished). Anticipation requires that a prior art reference disclose, either expressly or under the principles of inherency, each and every element of the claimed invention. *Id.* “In addition, the prior art reference must be enabling.” *Akzo N.V. v. U.S. International Trade Commission*, 808 F.2d 1471,

1479, 1 USPQ2d 1241, 1245 (Fed. Cir. 1986), cert. denied, 482 U.S. 909 (1987). That is, the prior art reference must sufficiently describe the claimed invention so as to have placed the public in possession of it. In re Donohue, 766 F.2d 531, 533, 226 USPQ 619, 621 (Fed. Cir. 1985). “Such possession is effected if one of ordinary skill in the art could have combined the publication’s description of the invention with his own knowledge to make the claimed invention.” Id.

Although Applicant does not agree with the pending rejections, Applicant has nonetheless amended each of independent claims 1, 15 and 28 to incorporate recitations not disclosed by any of the cited references. Claim 1, for example, has been amended to recite the limitations of dependent claim 11: “a failed email management system, wherein said failed email management system is configured and arranged to receive a notice of a failed email delivery including a failed email address, and to change a document delivery designation for an intended recipient of a failed email to receive documents only non-electronically.” Independent claims 15 and 28 have been amended to incorporate similar recitations from dependent claims 23 and 34, respectively.

In connection with the obviousness rejection of claim 11, the Examiner alleges that Daniels’ email system is further comprised of a failed email management system (regeneration processor 118, Fig. 1), wherein said failed email management system is configured and arranged to receive a notice of a failed email delivery including a failed email address (col. 4 lines 26-34), and to change a document delivery designation for an intended recipient of a failed email to receive documents non-electronically.” The Examiner also alleges that Quine also teaches *similar* features in col. 5, line 50 - col. 6, line 21 and col. 8, lines 42-46.

However, Applicant respectfully submits that none of the cited references teach or suggest “a failed email management system, wherein said failed email management system is configured and arranged to receive a notice of a failed email delivery including a failed email address, and to ***change a document delivery designation for an intended recipient of a failed email to receive documents only non-electronically.***” Rather, Applicant respectfully submits that while Daniels discloses physically delivering mail that could not be delivered electronically, Daniels does not teach or suggest any feature or functionality that ***“changes” a document delivery designation for an intended recipient of a failed email to receive documents only non-electronically.*** The following excerpts of Daniels -- all cited by the Examiner -- demonstrate Daniels’ deficiency:

The system may include a regeneration processor for causing a physical mail piece to be generated, corresponding to an electronic mail piece that has not been delivered.

See, Col. 2, lines 20-23.

\* \* \* \* \*

If the electronic mail piece is not delivered after a certain length of time, the message router 112 generates and sends a "failed to process" or "failed to deliver" message to status/regeneration processor 118, which (depending on the users configured system, which system is configurable) may cause a physical version of the undelivered electronic mail piece to be produced by printer 104 and physical inserter 106 and delivery by physical means.

See, Col. 4, lines 26-34.

\* \* \* \* \*

Although mail run datafile 220 contains information mainly for physical delivery, all documents to be delivered electronically have a corresponding entry in mail run datafile 220 in case the mail piece has to be delivered physically. Electronic mail pieces may require physical delivery, via regeneration processor 118 described in more detail hereinafter, if the electronic delivery mechanisms do not successfully deliver the electronic mail piece. For example, electronic mail piece

235 in FIG. 3 has a record in both mail run datafile 220 and electronic mail run datafile 222.

*See*, Col. 5, lines 36-45.

\* \* \* \* \*

For example, if web server 116 is specified by the first delivery preference 322, the output server subsystem 113 sends the electronic mail piece to web server 116. The system may be configured to wait for a preset amount of time, e.g. four days, for the recipient to access the web page where the electronic mail piece was delivered. If the recipient has not accessed the web page in the preset amount of time, the electronic mail piece is considered not be delivered. For other delivery mechanisms, the delivery failure may be detected more directly, e.g., in the case of a busy signal for a fax number.

If the electronic mail piece is not delivered according to the delivery mechanism specified in the first delivery preference 322, the corresponding document is processed according to the second delivery preference 324 until all the delivery preferences have been exhausted. Status for each electronic mail piece is reported to status/regeneration processor 118 and stored in the interlock file 400. It is important for the message router 112 to be provided with a complete electronic delivery package, that is an electronic mail piece with insert instructions 414 for each electronic delivery mechanism, because the electronic mail piece may be in process for many days after the electronic inserter 110 has processed the entire batch. For example, the message router 112 may have to wait days for the Web server 116 to be accessed before utilizing the second delivery option.

*See* Col. 7, lines 5-30.

\* \* \* \* \*

In particular, the status/regeneration processor 118, which may be a program executing on mail server 600 in FIG. 6, scans the interlock file 400 for documents whose status indicates that regeneration is necessary. For physical mail pieces this may occur because the physical inserter 106 generated a bad insert, e.g. an insert jammed. For electronic mail pieces, regeneration maybe necessary for those electronic mail pieces that have not been successfully delivered.

Accordingly, the regeneration processor 118 outputs a "regen" file 602 containing the piece identifiers 300 of the documents that need to be regenerated, printed by printer 104, and processed by physical inserter 106.

*See*, Col. 7, lines 45-57.

Applicant respectfully submits that -- as evidenced by the above excerpts -- Daniels does not teach or suggest “a failed email management system, wherein said failed email management system is configured and arranged to receive a notice of a failed email delivery including a failed email address, and to change a document delivery designation for an intended recipient of a failed email to receive documents only non-electronically.” In particular, Applicant respectfully submits that Daniels does not teach or suggest any feature or functionality that changes a document delivery designation, much less that changes a document delivery designation for an intended recipient of a failed email to receive documents only non-electronically.

Further, Applicant respectfully submits that none of the other cited references make up for Daniels’ deficiency in this regard. Quine, for example, merely discloses the use of alternate means of communication to deliver documents to recipients, while Reilly merely discloses systems and methods that automatically determine if the recipient of electronic mail that is unknown at the receiving server has left a “forwarding address.” The other references -- Bruce, Seestrom and Smith -- were cited for different reasons, and thus fail to make up for Daniels and Quine, and Reilly’s deficiencies. Accordingly, Applicant respectfully submits that none of the cited references teach or suggest any feature or functionality that changes a document delivery designation for an intended recipient of a failed email to receive documents only non-electronically. Claims 15 and 28 include recitations that are similar to claim 1 and thus should be allowable for at the reasons set forth above.

Claims 2-10, 12-14, 16-22, 24-27, 29-33, and 35-41 are dependent upon independent claim 1, 15 or 28. Thus, since independent claim 1, 15 and 28 should be allowable as discussed above, claims 2-10, 12-14, 16-22, 24-27, 29-33, and 35-41 should also be allowable at least by

virtue of their dependency on independent claim 1, 15 or 28. Moreover, these claims recite additional features which are not claimed, disclosed, or even suggested by the cited references taken either alone or in combination. For example, claim 39 recites the system of claim 1 wherein changing a document delivery designation comprises changing a stored document delivery designation so that future documents are delivered to the intended recipient only non-electronically. Applicant respectfully submits that none of the cited references -- alone or in combination -- teach or suggest the system of claim 1 wherein changing a document delivery designation comprises changing a stored document delivery designation so that future documents are delivered to the intended recipient only non-electronically.

In view of the foregoing, it is respectfully requested that the aforementioned anticipation rejection of claims 1, 15 and 28 be withdrawn.

III. THE OBVIOUSNESS REJECTION OF CLAIMS 2-14, 16-27 AND 29-38

On page 6 of the Office Action, claims 2-7, 10, 16-20, 22, 29-31 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniels in view of Quine (U.S. Patent No. 6,782,415). On page 10 of the Office Action, claims 11-13, 23-26 and 34-37 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniels and Quine and further in view of Reilly (U.S. Patent No. 6,427,164). On page 14 of the Office Action, claims 14, 27 and 38 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniels, Quine, Reilly, further in view of Bruce (U.S. Patent No. 6,741,724), and further in view of Seestrom (U.S. Patent No. 6,647,385). On page 15 of the Office Action, claims 8, 9, 21 and 32 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Daniels, Quine, and further in view of Smith (U.S. Patent No. 6,385,655). These rejections are hereby respectfully traversed.

As stated in MPEP § 2143, to establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant respectfully submits that the above obviousness rejections have been overcome by the amendments and remarks set forth above in connection with the anticipation rejections of claims 1, 15 and 28.

In view of the foregoing, it is respectfully requested that the aforementioned obviousness rejection of claims 2-14, 16-27 and 29-38 be withdrawn.

#### IV. CONCLUSION

In view of the foregoing, it is respectfully submitted that the present application is in condition for allowance, and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed telephone number, in order to expedite resolution of any issues and to expedite passage of the present application to issue, if any comments, questions, or suggestions arise in connection with the present application.

To the extent necessary, a petition for an extension of time under 37 CFR § 1.136 is hereby made.

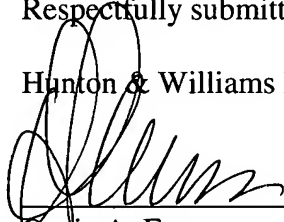


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Respectfully submitted,

Hunton & Williams LLP

By:

  
\_\_\_\_\_  
Ozzie A. Farres  
Registration No. 43,606

Hunton & Williams LLP  
1900 K Street, N.W.  
Washington, D.C. 20006-1109  
Telephone: (202) 955-1500  
Facsimile: (202) 778-2201

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